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EXAMINER

MENDOZA JR, JORGE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/675,466 | Applicant(s) KARAOGUZ ET AL. | |
| | Examiner JORGE MENDOZA JR | Art Unit 2623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 25-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims **1-35** are presented for Examination.
2. Claims **2-3, 5-7, 9-11, 13-15, 17-22, & 25-26** have been amended.
3. Claims **27-35** have been added.
4. Claim **24** has been cancelled.

Response to Arguments

5. Applicant's arguments filed 01/25/2008 have been fully considered but they are not persuasive with respect to Claims **1-26**.
6. Applicant argues that the rejection relying on **Sartain et al. (US Patent No. 5,914,712)** does not anticipate Claims **1, 7-9, 15, & 16** and fails to meet the claimed "calculating at least one statistic, using the information related to the request [for consumption of media]; identifying media using the at least one statistic; scheduling the identified media according to the at least one statistic [that is used to identify the media] for consumption via the communication network...". The Examiner respectfully disagrees. Sartain et al. has been relied upon to teach the identification of media, using the number of requests that a given video program has received to identify the most popular one & to schedule its position on a queue, according to the statistic or calculated number of subscribers that requested the video program (*col.5, line 57 - col.6, line 1*).

Applicant agrees that the rejection relying upon the combination of Sartain et al. and Lu does not render Claims **2-6** and **10-14** obvious. The Examiner respectfully disagrees for the reasoning previously set forth above.

Applicant argues that the rejection relying upon the combination of Lu and Sartain et al. does not render Claims **17-26** unpatentable. The Examiner respectfully disagrees for the reasoning previously set forth above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims **1, 7-9, 15 & 16** are rejected under 35 U.S.C. 102(b) as being anticipated by **Sartain et al. (US Pat# 5,914,712)**.

With respect to Claim **1**, the claimed “receiving, via a communication network, at least one notification of a user request for consumption of media, each of the at least one notification comprising information related to the request” is met by Sartain et al. that teaches a request by phone, set top box, or computer from a user to a cable provider via a phone line, whereby the request includes a video selection number, subscriber identification, and/or credit card information (*Fig.1&3; col.2, lines 60-64; col.3, lines 7-10, col.4, lines 51-55; col.4, lines 18-26, lines 36-43, and col.7, lines 14-20*).

The claimed “calculating at least one statistic, using the information related to the request; identifying media using the at least one statistic” is met by Sartain et al. that teaches the use of a queue in keeping a count of the number of selections a particular video obtains from subscribers & moving videos with more selections up in the queue, thereby identifying video selections with greater requests and making them available for viewing faster (*col.5, lines 44-64*).

The claimed “scheduling the identified media according to the at least one statistic, for consumption via the communication network” is met by Sartain et al. that teaches scheduling media for viewing on a given channel according to the number of requests that it receives (*col.5, 63-67 and col.6, lines 1-2*). The claimed “updating a user interface with the scheduled identified media” is met by Sartain et al. that teaches the updating of a scroll bar with the selection number of the video request in order to provide feedback to the subscriber (*Fig.2, col.3, lines 23-28; and col.4, lines 31-33*).

With respect to Claim **7**, the claimed “wherein one or more of the calculating, identifying, scheduling, and/or updating is performed on a periodic basis” is met by Sartain et al. teaching that the selectable media is updated once a day to once a week (*col.8, lines 42-43*).

With respect to Claim **8**, the claimed “at least one statistic is a ranking of the relative frequency of consumption of media” is met by Sartain et al. that teaches the use of a statistic, namely the number of subscribers who have requested a specific video, in scheduling a group of videos in a media channel- making those videos with a greater

number of requests have a greater ranking than those with fewer number of requests
(*col.5, lines 56-67 and col.6, lines 1-2*).

With respect to Claim **9** is met in part as previously discussed with respect to Claim **1**. The claimed “communicating one or both of the identified media and/or the at least one statistic to a provider of the media, via the communication network” is met by Sartain et al. that teaches that subscriber requests are received at a central location 120 and then sent to office 100, that compiles all of the ‘necessary/desirable video programs” to be sent to headends 110, 112, and 114 along with data related to the number of subscribers that have selected a particular video (*col.5, lines 57-62 and col.6, lines 12-38*).

Claim **15** is met as previously discussed with respect to Claim **7**.

Claim **16** is met as previously discussed with respect to Claim **8**.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims **2-6**, and **10-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sartain et al. (US Patent No. 5,914,712)** in view of **Lu (US Patent No. 7,065,778)**.

With respect to Claim **2**, Sartain et al. teaches a method of allowing individual subscribers to control the media programming being broadcast to a select group of subscribers. However, Sartain et al. does not teach the claimed “information comprises one or more of an Internet protocol (IP) address, a media access control (MAC) address, an electronic serial number (ESN), a title, a subject, a time period, a genre, an artist, a media channel type, a mode, a language, and/or a user identifier”. In the same field of endeavor, the Lu reference teaches a method of requesting media that involves a request that can include the IP address of the requesting party (*col.10, lines 10-15*).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to combine the teachings of Sartain et al. with those of Lu since both to them are inventions relating to a subscriber’s request for media. A person with ordinary skill in the art would have been motivated to make such a modification to Sartain et al. in order to allow individual subscribers a greater amount of selectable media and an alternate manner in which to identify subscribers requesting media.

With respect to Claim **3**, the claimed “ wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure” is met by Lu teaching a network in which the PVR’s 200, 200A, 200B, and EPG server 304 of network 300 can be connected by coaxial cable, copper wire, fiber optics, the Internet 302, and wireless communications (*Fig.3, and col.7, lines 1-8*).

With respect to Claim **4**, the claimed “wherein the communication network is the Internet” is met by Lu teaching a network in which the PVR’s 200, 200A, 200B, and EPG server 304 of network 300 can be connected by the Internet 302 (*Fig.3, & col.7, lines 1-8*).

With respect to Claim **5**, the claimed “wherein the media comprises one or more of audio, a still image, video, real time video, and/or data” is met by Lu teaching a network 300 that can operate with audio, video, graphics, information, data, software media content (*col.7, lines 25-28*).

With respect to Claim **6**, the claimed “wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data” is met by Lu teaching a display device 212 coupled to PVR 200 for displaying video, graphics, and/or alphanumeric characters (*Fig.3 & 4, and col.6, lines 21-28*).

Claim **10** is met as previously discussed with respect to Claim **2**.

Claim **11** is met as previously discussed with respect to Claim **3**.

Claim **12** is met as previously discussed with respect to Claim **4**.

Claim **13** is met as previously discussed with respect to Claim **5**.

Claim **14** is met as previously discussed with respect to Claim **6**.

8. Claims **17-23** and **25-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lu (US Pat# 7,065,778)** in view of **Sartain et al. (US Pat# 5,914,712)**.

With respect to Claim **17**, the claimed “a television display; a storage for storing media, the storage having an associated network address; a user interface accessible via the television display, the user interface supporting the selection of media for consumption; set top box circuitry communicatively coupling the storage to a communication network to support consumption of the selected media” is met by Lu that teaches a television 212 displaying an electronic programming guide (EPG) used to request specific media and a personalized video recorder having an associated network address and a storage device 218 (*Fig.2; col.5, lines 26-35; col.6, lines 17-28 and 39-45*).

The claimed “server software that receives via the communication network, a notification comprising at least one of the associated network address and information related to the media selected for consumption, and responds by calculating at least one statistic, identifying media using the at least one statistic, and scheduling availability of the identified media according to the at least one statistic” is met in part by Lu that teaches an EPG server 304 that receives a request from PVR 200, along with its network address, for a specific media program and determines whether or not PVR’s 200A or 200B connected to it will receive specific media programming (*Fig.3, col.9, lines 8-15 & lines 48-57; and col.10, lines 10-15*). However, Lu does not teach the claimed

“responds by calculating at least one statistic, and scheduling availability of the identified media according to the at least one statistic”.

In the same field of endeavor, Sartain et al. teach a method of allowing individual subscribers to control the media programming being broadcast to a select group of subscribers. Specifically, Sartain et al. teach the use of a queue in keeping a count of the number of selections a particular video obtains from subscribers and moving videos with more selections up in the queue, thereby scheduling the video programs according to the amount of selections it received (*col.5, lines 44-64*).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to combine the teachings of Lu with those of Sartain et al. since both to them are inventions relating to a subscriber's request for media. A person with ordinary skill in the art would have been motivated to make such a modification to Lu in order to permit subscriber's requests with higher demand to be placed in the cache server 402 and thereby yield a system with better efficiency.

With respect to Claim **18**, the claimed “wherein the media comprises one or more of audio, a still image, video, real time video, and/or data” is met by Lu that teaches the system of Claim **17** where the media may include audio, video, graphics, information, data, software and/or the like (*col.7, lines 25-28*).

With respect to Claim **19**, the claimed “wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data”

is met by Lu that teaches the consumption of media by way of displaying video and/or graphics on a display device 212 (*col.6, lines 23-28*).

With respect to Claim **20**, the claimed “wherein the associated network address is one of an Internet protocol (IP) address, a media access control (MAC) address, or an electronic serial number (ESN)” is met by Lu that teaches the use of an IP address for PVR 200 (*col.10, lines 10-15*).

With respect to Claim **21**, the claimed “wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure” is met by Lu that teaches a communication network in which the components are coupled via cable, copper wire, fiber optics, the Internet 302, wireless communication or the like (*Fig.3; col.7, line 1-8*).

With respect to Claim **22**, the claimed “wherein the information related to media selected for consumption comprises one or more of a title, a subject, a time period, a genre, an artist, a media channel type, a mode, a language, and/or a user identifier” is met by Sartain et al. that teach the use of subscriber selection time, video program selection number, subscriber selection time, or a credit card number in requesting a media program (*col.3, lines 51-54, & col. 4, lines 23-26*).

With respect to Claim **23**, the claimed “at least one statistic is a ranking of the relative frequency of consumption of media” is met by Sartain et al. that teaches the use

of a statistic, namely the number of subscribers who have requested a specific video, in scheduling a group of videos in a media channel (*col.5, lines 56-67 and col.6, lines 1-2*).

With respect to Claim **25**, the claimed “wherein the server software performs the scheduling of the availability of media on a periodic basis” is met by Lu that teaches an EPG server 304 that performs the scheduling of requested media upon a user’s request and upon determining requested media is available at a connected PVR (*col.9, lines 5-26*).

With respect to Claim **26**, the claimed “wherein the server software shares, with a third party, the at least one statistic” is met by Sartain et al. that teach transmittal of the selected video information to a central office for tracking purposes (*col.4, lines 49-53*).

Claim **27** is met as previously discussed with respect to Claim **17**.

Claim **28** is met as previously discussed with respect to Claim **18**.

Claim **29** is met as previously discussed with respect to Claim **19**.

Claim **30** is met as previously discussed with respect to Claim **21**.

Claim **31** is met as previously discussed with respect to Claim **22**.

Claim **32** is met as previously discussed with respect to Claim **23**.

Claim **33** is met as previously discussed with respect to Claim **25**.

Claim **34** is met as previously discussed with respect to Claim **26**.

Claim **35** is met as previously discussed with respect to Claim **17**.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jorge Mendoza Jr.** whose telephone number is (571) 270-5087. The examiner can normally be reached on Monday through Friday 7:30 am – 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Scott Beliveau** can be reached at (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JORGE MENDOZA JR/
Examiner, Art Unit 2623

/Scott Beliveau/
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